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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,250	12/05/2001	Russell J. Wilcox	H-313	8322
26245	7590	07/25/2005	EXAMINER	
DAVID J COLE E INK CORPORATION 733 CONCORD AVE CAMBRIDGE, MA 02138-1002			LY, NGHI H	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,250

Applicant(s)

WILCOX ET AL.

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-35,37,39 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-35,37,39 and 41-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 39 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 39, the claim recites "*the visual indicator is present on the rear surface and an opposed pair of the side and end surfaces.*" The specification page 11, lines 28-30, of the present invention discloses that "*the visual indicator be present on the rear surface and an opposed pair of the side and rear surfaces*". The enclosure does not disclose *the visual indicator is present on the rear surface and an opposed pair of the side and end surfaces*. Therefore, the above emphasized limitation was not described in the specification at the time the invention was filed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 32-35, 37 and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita (US 6,470,196) in view of Fernandez (US 4,851,820).

Regarding claim 32, Yamashita teaches a cellular telephone having a visual indicator (see fig.2, indicator 18) having at least two different display states (column 4, lines 32-33, see "blinks as a visible alert when an incoming call occurs", Yamashita's "blinks" reads on applicant's "two different display states"), the medium being arranged to change its display state when a call is received by the telephone (also see column 4, lines 32-33, see "blinks as a visible alert when an incoming call occurs", Yamashita's "blinks" reads on applicant's "two different display states"), the external surface of the cellular telephone comprises at least three separate surfaces (see fig.2, the device 100 comprises at least three separate surfaces) and the visual indicator is present on at least two of said separate surfaces (see fig.2, the indicator 118 is present on the top surface and front surface of device 100).

Yamashita does not specifically disclose a visual indicator comprising an electro-optic medium having at least two different display states, the electro-optic medium being arranged to change its display state when a call is received by the telephone.

Fernandez teaches a visual indicator comprising an electro-optic medium having at least two different display states (see column 4, lines 26-31, see "LCD", the teaching of Fernandez inherently teaches Applicant's "two different display states" since the indicator 26 of Fernandez can be on/off or "*alerted*" (or not "*alerted*")), the electro-optic medium being arranged to change its display state when a call is received by the telephone (also see column 4, lines 26-31, see "*alerted* of a call by the indicator").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Fernandez into the system of Yamashita in order an indication to the user whether he or she is in range of the of the transmitter (see Fernandez, column 2, lines 55-59).

Regarding claim 33, Yamashita teaches a cellular telephone wherein the medium is arranged to change repeatedly between said at least two different display states when a call is received by the telephone (column 4, lines 32-33, see "*blinks* as a visible alert when an incoming call occurs").

Yamashita does not specifically disclose the electro-optic medium is arranged to change repeatedly between said at least two different display states when a call is received by the telephone.

Fernandez teaches the electro-optic medium is arranged to change repeatedly between said at least two different display states when a call is received by the

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telephone (see column 4, lines 26-31, see "LCD", the teaching of Fernandez inherently teaches Applicant's "two different display states" since the indicator 26 of Fernandez can be on/off or "*alerted*" (or not "*alerted*")), when a call is received by the telephone (also see column 4, lines 26-31, see "*alerted* of a call by the indicator").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Fernandez into the system of Yamashita in order an indication to the user whether he or she is in range of the of the transmitter (see Fernandez, column 2, lines 55-59).

Regarding claim 34, Yamashita teaches the medium has at least two modes of changing repeatedly between said at least two different display states (column 4, lines 32-33, see "*blinks* as a visible alert when an incoming call occurs").

Yamashita does not specifically disclose the electro-optic medium.

Fernandez teaches the electro-optic medium (column 4, lines 26-31, see "LCD").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Fernandez into the system of Yamashita in order an indication to the user whether he or she is in range of the of the transmitter (see Fernandez, column 2, lines 55-59).

Regarding claim 35, the combination Fernandez and Yamashita teaches 32. The combination Fernandez and Yamashita does not specifically disclose the visual indicator covers an area of at least about 1 cm².

However, such visual indicator covers an area of at least about 1 cm² could have been obvious since the particular cover area could have been determined by the

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inventor's choices e.g., use an area of at least about 1 cm² can be easily seen by the user.

Regarding claim 37, the combination Fernandez and Yamashita teaches 32. The combination Fernandez and Yamashita does not specifically disclose the visual indicator covers at least about 5 per cent of the external surface of the cellular telephone.

However, such the visual indicator covers at least about 5 per cent of the external surface of the cellular telephone could have been obvious since the particular cover area could have been determined by the inventor's choices e.g., use the visual indicator covers at least about 5 per cent of the external surface of the cellular telephone can be easily seen by the user.

Regarding claim 42, the combination of Yamashita and Fernandez teaches the electro-optic medium of claim 32 (Fernandez, column 4, lines 26-31, see "LCD"), instead of the electro-optic medium comprises an electrophoretic medium as claimed.

However, the electro-optic medium comprises an electrophoretic medium is known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teaching of Fernandez and Yamashita in order to improve the electro-optic medium.

Regarding claim 43, the combination of Yamashita and Fernandez teaches the electro-optic medium of claim 32 (Fernandez, column 4, lines 26-31, see "LCD"),

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instead of the electrophoretic medium is an encapsulated electrophoretic medium as claimed.

However, the electrophoretic medium is an encapsulated electrophoretic medium is known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teaching of Fernandez and Yamashita in order to improve the electro-optic medium.

Regarding claim 44, the combination of Yamashita and Fernandez teaches the electro-optic medium of claim 32 (Fernandez, column 4, lines 26-31, see "LCD"), instead of the electro-optic medium comprises a rotating bichromal member medium as claimed.

However, the electro-optic medium comprises a rotating bichromal member medium is known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teaching of Fernandez and Yamashita in order to improve the electro-optic medium.

Regarding claim 45, the combination of Yamashita and Fernandez teaches the electro-optic medium of claim 32 (Fernandez, column 4, lines 26-31, see "LCD"), instead of the electro-optic medium comprises an electrochromic medium as claimed.

However, the electro-optic medium comprises an electrochromic medium is known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teaching of Fernandez and Yamashita in order to improve the electro-optic medium.

Regarding claim 46, the combination of Yamashita and Fernandez teaches the electro-optic medium of claim 32 (Fernandez, column 4, lines 26-31, see "LCD"), instead of the electrochromic medium is a nanochromic film comprising an electrode formed at least in part from a semi-conducting metal oxide and a plurality of dye molecules capable of reversible color change attached to the electrode as claimed.

However, the electrochromic medium is a nanochromic film comprising an electrode formed at least in part from a semi-conducting metal oxide and a plurality of dye molecules capable of reversible color change attached to the electrode is known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teaching of Fernandez and Yamashita in order to improve the electro-optic medium.

6. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita (US 6,470,196) in view of Fernandez (US 4,851,820) and further in view of Kaplan (US 6,032,039).

Regarding claim 41, the combination of Yamashita and Fernandez teaches the visual indicator (see Yamashita, fig.2, indicator 118 or see Fernandez, fig.4, indicator 4). The combination of Yamashita and Fernandez does not specifically disclose an audible

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indicator means for indicating when a call is received by the telephone, and selector means whereby a user may select operation of either the visual indicator means or the audible indicator means when a call is received by the telephone.

Kaplan teaches an audible indicator means for indicating when a call is received by the telephone, and selector means whereby a user may select operation of either the visual indicator means or the audible indicator means when a call is received by the telephone (see column 7, lines 32-35).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to provide the above teaching of Kaplan to the system of Yamashita and Fernandez so that the user can select one of these choices and provide appropriate indication.

Response to Arguments

7. Applicant's arguments with respect to claims 32-35, 37, 39 and 41-46 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone


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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

16/6
07/11/05


CHARLES APPIAH
PRIMARY EXAMINER